

REMARKS

Foreign Priority:

Applicant thanks the Examiner for acknowledging Applicant's claim to foreign priority under 35 U.S.C. § 119(a)-(d), and for confirming that the certified copy of the priority document has been received at the Patent Office in the parent Application no. 09/813,883.

Drawings:

Applicant thanks the Examiner for indicating that the drawings filed March 26, 2004 have been approved.

Information Disclosure Statement:

Applicant thanks the Examiner for initialing and returning Form PTO/SB/08 A & B filed with the present application, thus indicating that most of the references listed thereon have been considered.

The Examiner has crossed out a few of the references. Specifically, the Examiner has crossed out three duplicative patent references, and two non-patent publications. In crossing out the articles, the Examiner has indicated that their identification was not in accordance with 37 C.F.R. § 1.98(b). (See Office Action, page 2).

However, Applicant notes that as shown on page 2 of the Office Action, the Examiner has indicated that in accordance with MPEP § 609, the Examiner has reviewed and considered all of the references of record in the parent application. Thus, these references have been properly considered.

The Examiner has indicated, however, that because these references were not properly cited, they will not be listed on the face of any patent stemming from this application. To ensure that these references will be properly listed on the face of the patent, Applicant submits herewith an Information Disclosure Statement, properly identifying the articles.

Applicant hereby requests the Examiner initial the Form PTO/SB/08 A & B, to ensure these references are listed on the face of any patent stemming from the present application.

Claim Objections:

Claims 13 and 14 have been objected to, due to a spelling error. Applicant has corrected these errors as shown in the previous section.

Claim Rejections:

Claims 1-17 are all of the claims pending in the present application, and currently all of the claims stand rejected.

35 U.S.C. § 103(a) Rejection - Claims 1-11:

Claims 1-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over European Patent No. EP 898 421 to Imai in view of U.S. Patent No. 5,686,733 to Fallon et al., in further view of U.S. Patent No. 5,729,021 to Brauers et al. In view of the following discussion, Applicant respectfully traverses the above rejection.

The Examiner is relying on Figures 3A through 3D, of Imai, to disclose the majority of the features of the present invention. Namely, the Examiner asserts that Figure 3D discloses all of the claimed layers. However, the Examiner also recognizes that Imai does not expressly disclose a “substrate” as in the claimed invention. However, because Imai discloses that the first

electrode layer 5 can include a glass plate (see col. 17, lines 30-33), the Examiner asserts that the first electrode layer 5 teaches both the substrate and the first electrode layer, of the claimed invention.

Further, the Examiner recognizes that Imai does not disclose doping any of the recording photoconductive or reading photoconductive layers (both of which can be made from a-Se). For this teaching, the Examiner relies on Fallon to teach it is known to dope a photoreceptor layer of a-Se with either arsenic or chlorine (see col. 8, lines 64-65), and Brauers to teach that the use of 0.1% to 0.5% of Ar can be used to counteract recrystallization of a-Se. (Col. 6, lines 35-36).

However, in view of the following discussion, Applicant submits that the Examiner's above comments and assertions fail to establish a *prima facie* case of obviousness with respect to the claimed invention.

An object of the present invention is to suppress interfacial crystallization due to deposition of the recording light side electrode layer onto the recording photoconductive layer. This is discussed on page 9, lines 16-21, of the present application. The present invention makes it possible to form an electrode directly on a surface of the recording photoconductive layer without providing a cladding layer by doping the recording photoconductive layer with As in an appropriate amount. Namely, in the present invention, "the recording photoconductive layer is formed of a material containing a-Se as a major component and doped with a material for suppressing bulk crystallization of a-Se." *See* claim 1. This is neither taught or suggested in any of the above cited references, taken individually or in combination.

In view of the foregoing discussion, Applicant submits that the above references, taken individually or in combination, fail to teach or suggest each and every feature of the claimed invention. Therefore, Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness as required under the provisions of 35 U.S.C. § 103(a). Accordingly, Applicant hereby requests the Examiner reconsider and withdraw the above 35 U.S.C. § 103(a) rejection of claims 1-11.

35 U.S.C. § 103(a) Rejection - Claims 12-17:

Claims 12-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Imai in view of Fallone, in further view of Brauers, and in further view of U.S. Patent No. 4,990,420 to Urabe. However, because claim 12 contains similar limitations to those found in claims 1 and 8, Applicant submits that claims 12-17 are also allowable for at least the same reasons set forth above regarding claim 12. Specifically, none of the above references, taken individually or in combination, teach or suggest a method of making an image recording medium where “the recording photoconductive layer is formed in a thickness of 200 to 1000 μ m by resistance heating deposition of an alloy material containing therein Se as a major component and doped with 0.1 to 0.5atom% of As and 10 to 50ppm of Cl.” *See* claim 12.

Therefore, Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness as required under the provisions of 35 U.S.C. § 103(a). Accordingly, Applicant hereby requests the Examiner reconsider and withdraw the above 35 U.S.C. § 103(a) rejection of claims 12-17.

AMENDMENT UNDER 37 C.F.R. §1.111
Application Number 10/630,736

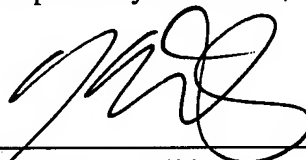
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Conclusion:

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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